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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,688	09/09/2003	Amy M. Seibert	3716/155	7527

7590

09/22/2004

BRINKS HOFER GILSON & LIONE

P.O. Box 10395

Chicago, IL 60610

EXAMINER

CEGIELNIK, URSZULA M

ART UNIT

PAPER NUMBER

3712

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/659,688

Applicant(s)

SEIBERT ET AL 

Examiner

Urszula M Cegielnik

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3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-14 and 18-28 is/are rejected.
- 7) ☒ Claim(s) 3,4 and 15-17 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/08/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5-9, 11-14, 18, 20-23, and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hale (US Patent No. 5,540,132).

Hale discloses a toy for being held on to or by a finger comprising a body having a top end and a bottom end; means for mounting (38) the toy on a finger; the means (38) coupled to the body (32c); a speaker (*the toy inherently includes a speaker, since it has a battery powered electronic device that can emit a tone, sentence or song, such as the electronic device available from Darice Inc. of Strongsville, Ohio for generating at least one sound*); mounted within the body (32c); a switch (44) electrically connected to the computer chip, and a finger tapper (40, *button which is tapped by finger*) movably mounted on the bottom end of the body (see Figure 2, for example) for momentary contact with the switch (44) application of finger pressure (*finger pressure which inherently involves a tapping motion*) to the electronic device, wherein when the finger tapper (40, *button which is tapped by finger*) is depressed, the switch (44) is actuated to cause the generation of the sound; the switch is a touch switch (col. 7, lines 45-46); each of the toys (32c,32d,32e,32f) generates a different sound and the eight sounds comprise an octave (*see Figure 1, although 4 character figures are shown, all eight*

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notes are present, for example); each of the toys is different (see Figure 1, for example) and the combination comprises a theme (*e.g. a musical scale, for example*).

It would have been obvious to one having ordinary skill in the art at the time the invention was made that "electronic devices" of this type contain "computer chips", therein for the storage of data (i.e. sounds, songs, and sentences (col. 7, lines 36-38).

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hale (US Patent No. 5,540,132) in view of Noble et al.

Hale discloses the claimed invention except for the means for mounting comprising a ring assembled between the front and the back and protruding through the back.

Noble et al. teach a ring (24) assembled between the front (12) and back (20) and protruding through the back (see Figure 1).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a ring located between the front and back and protruding through the back as an alternate arrangement of securing the finger puppet as taught by Noble et al., since Hale states at col. 7, lines 23-25, that an alternate structure may be secured to the back of the puppet.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hale (US Patent No. 5,540,132) in view of .

Hale discloses the claimed invention except for the head articulably mounted on the body.

Fukui teaches a head of a toy figure that is articulated.

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It would have been obvious to one having ordinary skill in the art at the time to provide a head that is articulably mounted as taught by fukui, since such a modification would be more appealing to a child.

Claims 10, 19, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hale in view of Rodgers.

Hale discloses the claimed invention except for mounting at least one LED on the body and a routine for flashing at least one pattern for the at least one LED.

Rodgers teaches mounting at least one LED on the body of a toy and a routine for flashing at least one pattern for the at least one LED (col. 3, lines 5-12).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to mount an LED on the body and provide a flashing pattern routine as taught by Rodgers, since such a modification would make the toy more appealing to a child.

Allowable Subject Matter

Claims 3, 4, and 15-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

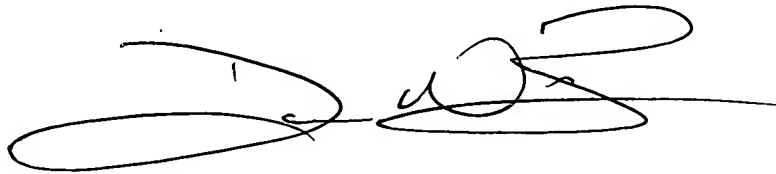
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Urszula M. Cegielnik whose telephone number is 703-306-5806. The examiner can normally be reached on Monday through Friday, from 5:45AM - 2:15PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H. Banks can be reached on 703-308-1745.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306 for both regular and After Final communications.

Urszula M. Cegielnik
Assistant Examiner
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A handwritten signature in black ink, appearing to read 'D. Banks', with a large, stylized flourish extending to the right.

**DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700**